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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR  | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|-----------------------|---------------------|------------------|
| 09/827,177  | 04/06/2001  | Alejandro H. Abdelnur | 80168-0121          | 4373             |
| 32658   | 7590        | 02/10/2006            | EXAMINER            |                  |
| HOGAN & HARTSON LLP<br>ONE TABOR CENTER, SUITE 1500<br>1200 SEVENTEEN ST.<br>DENVER, CO 80202 |             |                       | KESACK, DANIEL      |                  |
|   |             |                       | ART UNIT            | PAPER NUMBER     |
|   |             |                       | 3624                |                  |

DATE MAILED: 02/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |  |                     |  |
|------------------------------|------------------------|--|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> |  | <b>Applicant(s)</b> |  |
|                              | 09/827,177             |  | ABDELNUR ET AL.     |  |
|                              | <b>Examiner</b>        |  | <b>Art Unit</b>     |  |
|                              | Dan Kesack             |  | 3624                |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 2 and 4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 5-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1, 3, 5-18, drawn to matching an active order.
  - II. Claims 2 and 4, drawn to passivating an active order.
2. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as matching an active order with a matching order, which is not possible using the invention of claim II. See MPEP § 806.05(d).
3. During a telephone conversation with Bill Kubida on January 12, 2006 a provisional election was made without traverse to prosecute the invention of Group I, claims 1, 3, 5-18. Affirmation of this election must be made by applicant in replying to this Office action. Claims 2 and 4 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. Applicant is respectfully advised to cancel non-elected claims 2 and 4.

***Claim Objections***

4. Claim 5 objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim must refer back to the claim from which it depends in the alternative only. Claim 5 recites "The method for matching an order of claims 1 and 2." See MPEP § 608.01(n). Since applicant did not elect claim 2 as a result of the restriction, Examiner will treat claim 5 as depending from claim 1 only, for the purposes of examination

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:
- The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
6. Claims 9, 11-13, 15, 16, 18 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 recites the limitation "passive orders" in claim 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 11 recites the limitation "distance calculation" in claim 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 12 recites the limitation "passivating step" in claim 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 13 recites the limitation "name value pair" in claim 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 15 recites the limitations "rule based filter", "passive orders", and "name value pairs" in claim 1. There is insufficient antecedent basis for these limitations in the claim.

Claim 16 recites the limitations "passive orders" and "distance calculation" in claim 1. There is insufficient antecedent basis for these limitations in the claim.

Claim 18 recites the limitation "disaggregating". Claim 1, from which claim 18 depends, does not recite an aggregated order, or an order of type that may be "disaggregated." Therefore, there is insufficient antecedent basis for these limitations in the claim.

7. Claim 15 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to

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make and/or use the invention. The specification does not teach the rule-based filter rejecting a match between active and passive orders which include identical name value pairs.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claim 1, 3, 5, 6, 8-14, 16, rejected under 35 U.S.C. 102(e) as being anticipated by Luke et al., U.S. Patent No. 6,131,087.

Claims 1, 3, 5, 6, 16, Luke discloses a method for automatically identifying, matching, and near-matching buyers and sellers in electronic market transactions. Luke teaches solicitations for goods and services being received, said solicitations containing dimensions, including a product identifier, price, payment date, delivery destination (column 5 lines 62-67), said dimensions expressed in numeric terms on a linear scale by converting the dimensions from

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every solicitation to a standard format (column 6 lines 1-11), and matching offer and solicitation data from market participants and notifying originators of the matching data of the results of any such matching operations (column 6 lines 16-19).

Claim 3, 13, Luke teaches that solicitations and offers have a number of dimensions associated therewith, each dimension has a name and a value associated with it, and each solicitation dimension is compared to the offer dimensions, according to a series of rules as described in columns 7 and 8, and based on these rules, it is determined whether a match exists.

Claims 8, 12, Luke teaches matching offers is conducted by searching through standing solicitations data stored in a solicitations database, including the dimensions for each solicitation (column 7 lines 17-18).

Claim 9, 10, 14, Luke teaches comparing the normalized dimensions of standing and current solicitation data in order to determine if an intersection occurs, intersections occurring as perfect matches, or near-matches (figures 2C, 2D and column 8).

Claim 11, Luke teaches searching for a match using the “preferred” data point of a dimension of a solicitation, and increasing the range of the solicited

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dimension by expanding the search to include lower and upper limits, if no match is found (figure 2A).

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claim 7 rejected under 35 U.S.C. 103(a) as being unpatentable over Luke et al.

Luke teaches the normalized dimensions including a set of orthogonal axes (figure 1B). Luke fails to teach the axes having a value from 0 to 1.



Luke teaches that the dimensions of a solicitation can be normalized to a suitable linear scale so that matching queries may be conducted. It would be obvious to one of ordinary skill in the art at the time of the Applicant's invention modify this teaching to use a scale of 0 to 1 because this is a scale commonly used when comparing a set of normalized data, and it would constitute a suitable scale, which is taught by Luke.

13. Claims 17 and 18 rejected under 35 U.S.C. 103(a) as being unpatentable over Luke as applied to claims 1, 3, 5-16 above, and further in view of Walker et al., U.S. Patent No. 6,418,415.

Luke fails to teach aggregating a set of orders, and disaggregating and resubmitting a remainder offer after a match has been completed.

Walker discloses a system and method for aggregating multiple buyers, in an offer matching system, in which a buyer's conditional purchase offer (CPO) is grouped into an aggregate CPO, which then may be offered as a single solicitation. If a buyer's CPO is accepted, the status of the individual CPO is changed to "completed" and the aggregate CPO is changed to reflect the aggregate CPO containing only the remaining solicitations (column 3 lines 38-49). It would be obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Luke to include the teachings of Walker because the aggregation of buyers provides benefits to buyers by

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creating buying power associated with volume purchasing, and benefits sellers by increasing business and lowering per-transaction costs.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Kesack whose telephone number is 571-272-5882. The examiner can normally be reached on M-F, 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**HANI M. KAZIMI  
PRIMARY EXAMINER**